

REMARKS

Claims 1 and 3-29 are pending with Claims 1, 16, 27 and 28 being independent.

In the April 19, 2006 Office Action, the Examiner rejected claims 1 and 3-29 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,884,032 to Bateman et al. (“Bateman”) in view of U.S. Patent No. 5,327,486 to Wolff et al. (“Wolff”).

Applicant filed an Amendment and Response Under 37 C.F.R. § 1.111 on July 19, 2006, in which the Applicant traversed the rejection under 35 U.S.C. § 103(a).

On October 13, 2006, the Patent Office mailed a final Office Action in which the Examiner maintained the rejection claims 1 and 3-29 under 35 U.S.C. § 103(a). This rejection is respectfully traversed. Applicant respectfully requests the Examiner to reconsider and withdraw the current rejections in view of the following remarks.

The Rejections Under 35 U.S.C. § 103(a)

Independent Claim 1 requires, *inter alia*, an apparatus for caller information retrieval that includes a customer service response system (CSRS) capable of responding to an incoming telephone call from a calling party by playing a message to the calling party, and a graphical user interface (GUI) electrically coupled to the CSRS and configured to receive and display information from the CSRS, wherein the information received from the CSRS originates from the calling party, and wherein via a soft-key or graphical button, the GUI is configured to selectively initiate another message being sent from the CSRS to the calling party. Independent claims 16, 17, and 29 recite similar features.

To establish such a *prima facie* case of obviousness, the prior art references must teach or suggest all the claim limitations. There must also be some objective suggestion or motivation to modify a reference or combine reference teachings, and a reasonable expectation of success with

respect to making the modification or combination. Moreover, it is improper for the Examiner to modify a reference in such a way that would change the principle of operation of the prior art reference being modified. MPEP § 2143. For at least the reasons set forth below, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness of Claims 1 and 3-29.

In the October 13, 2006 final Office Action, the Examiner continues to rely on the portions of Bateman at: Fig. 1, workstation 18; col. 8, lines 62-65; col. 9, lines 10-12; col. 5, lines 26-27 and lines 35-36; and col. 6, lines 25-27 and lines 31-32, as allegedly showing the feature set forth in Applicant's Claim 1 of a graphical user interface (GUI) configured to receive and display information from the customer service response system (CSRS), wherein said information received from said CSRS originates from said calling party. (Office Action, pages 2-3 and 5-6). Applicant respectfully disagrees with this interpretation of Bateman.

Bateman describes a system in which a web browser located on an agent's computer 18 can be configured to display the same web page that prompted a question by the customer, so that the agent can answer any questions the customer has regarding that page (also referred to as "collaborative mode"; col. 10, ll. 47-50). The customer submits a URL for the web page via customer computer 4. Subsequently, the agent's computer 18 uses (but does not display) that URL to retrieve and display the corresponding web page. The customer also submits supply a telephone number (CLID) via computer 4. Subsequently, the agent's computer 18 can use that information to retrieve and display database records (i.e., customer account information) corresponding to the customer-specified number. (col. 8, line 62 to col. 9, line 32). Thus, the deficiency in Bateman is clear -- in each instance, the agent's computer 18 uses the information originated by the customer to retrieve and display other information (not information originating

from the calling party). In the Bateman system, agent computer 18 does not receive and display the customer-originated information itself.

Furthermore, there is no motivation to modify Bateman in order to cause agent computer 18 to display the URL and/or CLID originated by the customer, especially when one considers the context and stated purpose of the Bateman system. No such suggestion or motivation exists within Bateman to make such a modification. In fact, Bateman explicitly teaches away from a modification to the Bateman system which would cause it to display caller-originated information when Bateman states that it is an "object of the invention to make this process faster and simpler so as to improve the likelihood of a successful connection to a live agent". (col. 2, lines 1-3). Requiring the agent computer 18 to display the caller-originated information before using the same would increase the amount of time and complexity required for the agent to respond to customer inquiries. As a result, longer delays would be experienced and customers would be more likely to abandon their inquiries.

For completeness, the portions of Bateman cited and relied on by the Examiner are summarized below:

Fig. 1, workstation 18 and col. 5, lines 26-27: describe that computer/workstation 18 belonging to an Automatic Call Distribution (ACD) agent is capable of supporting a web browser.

Col. 8, lines 62-65: describes that when the agent answers a call having the customer on the other end, the customer's URL and/or CLID are forwarded so that a customer relevant screen (i.e., the corresponding web page and/or account information) appears on the agent's terminal 114 at the same time.

Col. 9, lines 10-12: describes that screen pop-up software takes the telephone numbers

provided by the CLID box, looks up the corresponding customer records in a database, and displays them on-screen.

Col. 5, lines 35-36: describes that call centre 24 handles requests for help from customers after the requests are received by WWW server 28.

Col. 6, lines 25-27 and lines 31-32: customer sends a completed HTML request off to the WWW server 28 where it is received by the HTTP server 46 and time-stamped; at the call centre, the help request messages are received and initially processed by the HTTP server 46.

In view of the foregoing, Applicant respectfully requests the Examiner to reconsider and withdraw the rejections of Claim 1 under 35 U.S.C. § 103(a).

In the October 13, 2006 final Office Action, the Examiner also acknowledges that Bateman does not "specifically teach via a soft-key or graphical button of (sic.) the GUI is configured to selectively initiate another message being sent from the CSRS to the calling party" as required by Claim 1, but maintains the allegation that this feature would have been obvious from either: (i) teachings allegedly notoriously well-known in the art of ACDs ("it would have been obvious that an agent from the ACD [of Bateman] may easily initiate another message and click the send button to send to the calling party. This feature is notoriously well-known in the art of ACDs." Office Action, page 3.); and/or (ii) various cited portions of Wolff ("The feature of using a soft-key or graphical button of the GUI to initiate a message being sent from the CSRS to the calling party is taught by Wolff (abstract; col. 4, line 55 through col. 5, line 12)"). Applicant respectfully disagrees.

As described above, the Examiner points to the agent's computer 18 in Bateman, and more specifically to the browser operating on computer 18, as allegedly showing the GUI required by Claim 1. (Office Action, pages 2-3 and 5-6). However, Applicant respectfully

submits that the Examiner has not met his burden of presenting a convincing line of reasoning why one of ordinary skill in the art would be motivated to modify the browser of Bateman in the manner the Examiner suggests. *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985) ("To support the conclusion that the claimed invention is directed to obvious subject matter . . . the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references."). In the Bateman system, the agent uses the web browser of computer 18 to view the same web page as the customer and/or to view the customer's account information. Simultaneously, the agent uses telephone 14 to maintain a voice connection with the customer. The Office Action is silent as to how the browser could be modified to accommodate a messaging functionality between the agent and the customer. Additionally, the presence of a simultaneous voice connection between the agent and the customer begs the unanswered question why one of ordinary skill in the art would be motivated to modify the browser in the first instance.

It appears that the Examiner has taken Official Notice with respect to the allegedly "notoriously well-known" functionality related to messaging between an agent and a customer in the art of ACDs. The law is clear that if such notice is taken, the Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See MPEP § 2144.03(C) and *In re Soli*, 317 F.2d 941, 946, 137 USPQ 797, 801 (CCPA 1963) and *In re Chevenard*, 139 F.2d 711, 713, 60 USPQ 239, 241 (CCPA 1943). Applicant respectfully submits that the Examiner has not met this burden for at least the reasons described above. If the Examiner continues to take Official Notice with respect to this allegedly "notoriously well-known" feature, Applicant respectfully requests the Examiner

to provide a reference in support of this Official Notice, as is Applicant's right pursuant to 37 C.F.R. §1.104(d)(2) and MPEP § 2144.03(C), in order to allow the Applicant to more fully consider and respond to the rejection.

The portions of Wolff cited and relied on by the Examiner (i.e., abstract and col. 4, line 55 through col. 5, line 12) also do not provide the necessary motivation to modify Bateman or to combine reference teachings in order to arrive at the system defined by Claim 1. The cited portions of Wolff describe a two-way wireless data messaging system in which an end-user of portable computer 18 only transmits text messages to a caller (i.e., via the end-user's "electronic receptionist") when the end-user does not wish to establish a voice communication with the caller (e.g., FIG. 9 shows a message indicating that the end-user will return the call at a later time). Alternatively, when the end-user of computer 18 desires to establish a voice connection with a caller, the end-user sends a text message to the end-user's electronic receptionist, and not the caller, instructing the receptionist to establish the voice connection to a telephone number identified by the end-user (e.g., FIG. 7). Thus, the cited portions of Wolff provide no such motivation to modify Bateman or combine reference teachings, since the agent and customer in the Bateman system already communicate over a voice connection ("Live Help").

Accordingly, the Examiner is respectfully requested to withdraw the rejections of Claim 1 under 35 U.S.C. § 103(a) for these additional independent reasons.

Independent Claims 16, 27 and 28 are not rendered obvious by Bateman alone or in combination with Wolff for at least the reasons stated above with respect to Claim 1. Thus, the rejections of claims 16, 27, and 28 are respectfully traversed. The Examiner is requested to reconsider and withdraw his rejections of claims 16, 27, and 28.


Claims 3-15, 17-26, and 29 are dependent on claims 1, 16, and 27, respectively. Thus,

claims 3-15, 17-26, and 29 are not rendered obvious for at least the reasons stated above with respect to claim 1. Thus, the rejections of claims 3-15, 17-26, and 29 are respectfully traversed. The Examiner is requested to reconsider and withdraw his rejections of Claims 3-15, 17-26, and 29.

The claims currently presented are proper and definite. Allowance is accordingly in order and respectfully requested. However, should the Examiner deem that further clarification of the record is in order, we invite a telephone call to the Applicant' undersigned attorney and agent to expedite further processing of the application to allowance.

Respectfully submitted,

Dated: December 13, 2006


Richard M. Leher, Esq., Reg. No.: 38,536
Peter F. Snell, Reg. No.: 52,235
Attorney/Agent for Applicant
MINTZ LEVIN COHN FERRIS, et al.
666 Third Avenue
New York, NY 10017
Telephone: (212) 935-3000
Telefax: (212) 983-3115